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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/216,538 03/23/94 GOELET

P 639103CIP

EXAMINER

SISSON, B

ART UNIT

PAPER NUMBER

1807

DATE MAILED:

01/20/95

JEFFREY I. AUERBACH  
HOWREY & SIMON  
1299 PENNSYLVANIA AVE., NW  
WASHINGTON, DC 20004

18N1/0120

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-31 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1-31 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 243.
14. ☐ Other

**EXAMINER'S ACTION**

**Restriction Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-8, drawn to nucleic acid, classified in Class 536, subclass 23.1.

Group II. Claims 1-14, drawn to a method of determining the extent of genetic similarity between horses, classified in class 435, subclass 6, and claims 15-19, also drawn to said method, classified in Class 435, subclass 91.2.

Group III. Claims 20-24, drawn to a method for determining the probability that a target horse will have a particular trait, classified in Class 435, subclass 6.

Group IV. Claims 25-29, drawn to a method for creating a genetic map of unique sequence equine polymorphisms, classified in Class 435, subclass 6.

Group V. Claims 30 and 31, drawn to a method for identifying a single nucleotide polymorphic site in genomic DNA that can be derived from humans, classified in Class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and II-V are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product as claimed can be used in any one of the other processes.

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The inventions of Groups II-V are distinct one from the other as they are comprised of different method steps and result in different end-products.VI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or because of their divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Jeffrey I. Auerbach, Reg. No. 32,680, on January 18, 1995 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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**Remarks**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*B. L. Sisson*

Bradley L. Sisson,  
Assistant Examiner

January 18, 1995

MARGARET PARR  
SUPERVISORY PATENT EXAMINER  
GROUP 1800